

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

**Disposition of Claims**

Claims 1-13 were pending in this application. Claims 1, 12, and 13 are independent. The remaining claims depend, directly or indirectly, from independent claim 1. Claims 2, 3, and 6-8 have been cancelled by way of this reply without prejudice or disclaimer. New dependent claim 14 and new independent claim 15 have been added by way of this reply.

**Claim Amendments**

Claims 2, 3, and 6-8 have been cancelled by way of this reply without prejudice or disclaimer. Claims 1, 5, and 9-13 have been amended by way of this reply. Support for these claim amendments may be found in, for example, paragraphs [0026]-[0031], [0033]-[0039], [0051], and [0056] of the originally-filed specification. New dependent claim 14 and new independent claim 15 have been added by way of this reply. Support for the aforementioned new claims may be found, for example, in paragraphs [0026]-[0031], [0033]-[0039], [0051], and [0056] of the originally-filed specification. Applicant submits that no new subject matter has been included by these claim amendments.

**Objection to Information Disclosure Statement**

The Examiner contends that the Information Disclosure Statement filed June 15, 2006 fails to comply with the 37 CFR § 1.97, § 1.98, and MPEP § 609 because Foreign Patent Documents EP-1013517A2, DE-10132031A1, and EP-1239420A1 did not come with an English translation or explanation of relevance. *See* OA: page 2 #1.

However, MPEP § 609.04(a)(III) clearly states that: “Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report.”

Applicant’s Information Disclosure Statement (IDS) filed June 15, 2006 provided an English language copy of a search report from a foreign patent office for a counterpart foreign application. *See* International Search Report for PCT/IB2004/004156 dated October 27, 2005. The aforementioned IDS cited Foreign Patent Documents EP-1013517A2, DE-10132031A1, and EP-1239420A1 with the indications of “X” and “A” respectively. Accordingly, the requirement for a concise explanation of relevance for these aforementioned Foreign Patent Documents is satisfied under MPEP § 609.04(a)(III). For at least these reasons, withdrawal of the objection and consideration of the aforementioned Foreign Patent Documents are respectfully requested.

## **Objections to the Specification**

### **I. With regards to the abstract**

The Examiner objects to the Specification on grounds that the abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR § 1.52(b)(4). *See* OA: page 2 #2.

MPEP § 1893.03(e) states that: “The requirement of 37 CFR 1.52(b) that the abstract “commence on a separate physical sheet or electronic page” does not apply to the copy of the published international application communicated to the designated Offices by the International Bureau under PCT Article 20. Accordingly, it is improper for the examiner of the U.S. national state application to require the applicant to provide an abstract commencing on a separate sheet if the abstract does not appear on a separate sheet in the publication of the international application ... the abstract that appears on the cover page of the published international application will be the abstract published by the USPTO under 35 U.S.C. § 122(b) and in any U.S. patent issuing from the application.” (emphasis added)

An abstract was provided as part of international application PCT/IB2004/004156. Per MPEP § 1893.03(e), the requirement of 37 CFR 1.52(b) that the abstract “commence on a separate physical sheet or electronic page” does not apply. As such, the abstract that appears on the cover page of PCT/IB2004/004156 as published may be the abstract published by the USPTO and in any resulting U.S. patent issuing from this application. Accordingly, withdrawal of the objection is respectfully requested.

II. With regards to the mislabeling informality in the disclosure

The Examiner objects to the disclosure because of the mislabeling informality described on page 2 of the OA last paragraph. Specifically, the Examiner notes that page 8 line 44 of the disclosure cites “spectrum generator 44” whereas the corresponding feature in FIG. 4 is labeled “54.” In responding to the Examiner’s objection, Applicant has amended paragraph [0051] of the specification by way of this reply to correct the aforementioned informality. Accordingly, withdrawal of the objection is respectfully requested.

**Rejections under 35 U.S.C. § 112**

The Examiner has rejected originally-filed claim 3 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. *See* OA: page 3 #5-6. Claim 3 has been cancelled by way of this reply without prejudice or disclaimer. Accordingly, the rejection is moot and withdrawal is respectfully requested.

**Rejections under 35 U.S.C. § 103**

Claims 1, 2, 5, 7-9, 12, and 13

I. Regarding claims 1, 2, 5, 7-9, and 12

Claims 1, 2, 5, 7-9, and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent Application Publication No. 2002/0128030 (“Eiden”) in view of U.S. Patent Application Publication No. 7,164,885 (“Jonsson”). As discussed, claims 7 and 8 have been cancelled without prejudice or disclaimer by way of this reply. Accordingly, the rejection is moot with respect to

claims 7 and 8. To the extent the rejection applies to the currently pending claims, the rejection is respectfully traversed.

Amended independent claim 1 recites, in part, “wherein a control means in the independent portable device adapted is configured to: remain in a low-powered stand-by mode until a data signal is received by the over skin receiver; receive a data signal comprising the connection code by the over skin communication receiver; transition to an active mode when the data signal is received.” Accordingly, amended independent claim 1 explicitly requires, in part, (i) an independent portable device to function in a low-powered stand-by mode until (ii) a data signal is received by an over skin receiver for the independent portable device (iii) at which time the independent portable device will transition to an active mode.

Applicant respectfully asserts that Eiden is silent with respect to the aforementioned limitations. Eiden is directed to the establishing of user groups among wireless devices based on a physical contact criteria at the time of group creation. See Eiden: Abstract. Eiden does not contemplate a low-powered stand-by mode in addition to an active mode for the wireless terminals discussed therein. Accordingly, Eiden cannot be construed to disclose the transition from a low-powered stand-by mode to an active mode for an independent portable device when a data signal is received by an over skin receiver of the independent portable device.

Applicant further asserts that Jonsson fails to disclose or otherwise provide that which Eiden lacks. Jonsson is directed to the use of service profiles among wireless devices for purposes of matching a service-seeking device with a service-providing device with respect to a particular service. See Jonsson: column 1 lines 40-52; and column 2 lines 15-29. Applicant respectfully asserts that Jonsson does not contemplate a low-powered stand-by mode in addition to an active

mode for the wireless devices discussed therein. Further, Jonsson is silent as to any of the wireless devices discussed therein possessing an over skin receiver. For at least these reasons, Jonsson cannot be construed to disclose or render obvious the transition from a low-powered stand-by mode to an active mode for an independent portable device when a data signal is received by an over skin receiver of the independent portable device.

In view of the arguments presented above, amended independent claim 1 is patentable over Eiden and Jonsson. Independent claim 12 includes at least the same patentable limitations and are therefore patentable over Eiden and Jonsson for at least the same reasons as discussed in relation to amended independent claim 1. Dependent claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

## II. Regarding Claim 13

Claim 13 stands rejected under 35 U.S.C. § 103 as unpatentable over Eiden in view of Jonsson. To the extent the rejection applies to the amended claim 13, the rejection is respectfully traversed.

Amended independent claim 13 recites, in part: “receive a first signal transmitted by a radiofrequency transceiver of the independent portable device when the class of the independent portable device matches the terminal identification class comprised in the connection code, wherein the first signal comprises the first random number”; “transmit, to the independent portable device, a request for the second random number”; “receive a second signal transmitted by the radiofrequency transceiver of the independent portable device, wherein the second signal comprises the second random number”, and “wherein when (i) the first random number comprised in the first signal matches the first random number comprised in the connection code and (ii) the second random

number comprised in the second signal matches the second random number comprised in the connection code, the terminal and the independent portable device are enabled to execute a transaction.” Accordingly, amended independent claim 13 requires, in part, that the radiofrequency transceiver of the terminal receives a first random number and a second random number from the independent portable device. Further, amended independent claim 13 requires, in part, that, for enablement of the terminal and the independent portable device to execute a transaction, the first random number and the second random number as sent to terminal must match the first random number and the second number as transmitted by the terminal as part of a connection code.

Turning to the rejections of originally-filed claims 10 and 11, the Examiner admits that neither Eiden nor Jonsson disclose or render obvious the aforementioned limitations of amended independent claim 13 involving a first random number and a second random number. *See* OA: page 10 last paragraph and page 12 second paragraph. Instead, the Examiner relies upon U.S. Patent Application Publication No. 2002/019796 (“Annola”) to disclose the aforementioned limitations. *See* OA: page 11 second paragraph and page 12 third paragraph. Annola is directed to the prevention of discovery (*i.e.*, hiding) of wireless devices in close proximity to one another. *See* Annola: Abstract. While Annola does contemplate the sending of a random number from one wireless device to another, Annola does not (as the Examiner acknowledges: *see, e.g.*, page 11 lines 6-9 of the OA) explicitly disclose the checking of the sent random number by the recipient wireless device. Accordingly, because Annola does not even explicitly contemplate such a checking step, Applicants respectfully assert that Annola further does not disclose or render obvious the checking of the random number by the recipient wireless device as a condition for enabling execution of a transaction between a terminal and an independent portable device. For at least these reasons,

Applicants respectfully assert that Annola cannot be properly construed to disclose or render obvious the limitation “wherein when (i) the first random number comprised in the first signal matches the first random number comprised in the connection code and (ii) the second random number comprised in the second signal matches the second random number comprised in the connection code, the terminal and the independent portable device are enabled to execute a transaction” recited by amended independent claim 13.

In view of the arguments presented above, amended independent claim 13 is patentable over Eiden, Jonsson, and Annola. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claims 3 and 4

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as unpatentable over Eiden and Jonsson and further in view of U.S. Patent Application Publication No. 2004/0128030 (“Hurwitz”). As discussed above, claim 3 has cancelled without prejudice or disclaimer by way of this reply. Accordingly, the rejection is moot with respect to claim 3 and withdrawal is respectfully requested. To the extent the rejection applies to claim 4, the rejection is respectfully traversed.

As discussed above, neither Eiden nor Jonsson disclose each and every limitation recited by amended independent claim 1. Further, Applicant respectfully asserts that Hurwitz fails to disclose or otherwise provide that which Eiden and Jonsson lack. Hurwitz is directed to a mobile communication device that is secured by an electronic token. *See* Hurwitz: Abstract. Applicant respectfully asserts that Hurwitz does not contemplate a low-powered stand-by mode in addition to an active mode for the mobile communication devices discussed therein. While Hurwitz does generally discuss the use of biometrics for purposes of user authentication, Hurwitz is silent as to



any of the mobile communication devices discussed therein possessing an over skin receiver. Further, assuming *arguendo* Hurwitz discloses an over skin receiver, Applicant respectfully asserts that Hurwitz is silent as to the transitioning from a low-powered stand-by mode to an active mode when a data signal is received by an over skin receiver. For at least these reasons, Hurwitz cannot be construed to disclose or render obvious the transition from a low-powered stand-by mode to an active mode for an independent portable device when a data signal is received by an over skin receiver of the independent portable device.

In view of the arguments presented above, amended independent claim 1 is patentable over Eiden, Jonsson, and Hurwitz. Dependent claim 4 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over Eiden and Jonsson and further in view of U.S. Patent No. 6,104,913 (“McAllister”). As discussed above, claim 6 has cancelled without prejudice or disclaimer by way of this reply. Accordingly, the rejection is moot with respect to claim 6 and withdrawal is respectfully requested.

#### Claims 10 and 11

Claims 10 and 11 stands rejected under 35 U.S.C. § 103 as unpatentable over Eiden and Jonsson and further in view of U.S. Patent Application Publication No. 2002/019796 (“Annola”). To the extent the rejection applies to the amended claims, the rejection is respectfully traversed.

As discussed above, neither Eiden nor Jonsson disclose each and every limitation recited by amended independent claim 1. Further, Applicant respectfully assert that Annola fails to disclose or otherwise provide that which Eiden and Jonsson lack. Annola is directed to the prevention of discovery (*i.e.*, hiding) of wireless devices in close proximity to one another. *See* Annola: Abstract. Applicant respectfully asserts that Annola is silent with regards to an over skin receiver for any of the wireless devices discussed therein. For at least these reasons, Annola cannot be construed to disclose or render obvious the transition from a low-powered stand-by mode to an active mode for an independent portable device when a data signal is received by an over skin receiver of the independent portable device.

In view of the arguments presented above, amended independent claim 1 is patentable over Eiden, Jonsson, and Annola. Dependent claims 10 and 11 are therefore patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

### **New Claims**

New claim 14 depends directly from amended independent claim 1 and is therefore allowable over the cited prior art for at least the same reasons as discussed above in relation to amended independent claim 1. Support for new claim 14 may be found, for example, in paragraph [0056] of the originally-filed specification.

New claim 15 includes the same or similar limitations as independent claim 1 and is therefore allowable over the cited prior art for at least the same reasons as discussed above in relation to amended independent claim 1. Support for new claim 15 may be found, for example, in paragraphs [0026]-[0031], [0033]-[0039], [0051], and [0056] of the originally-filed specification.

In view of the above, Applicant respectfully requests favorable action in the form of a Notice of Allowability.

### **Conclusion**

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/089001).

Dated: March 22, 2010

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